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**OCT 05 2004**

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In re Application of	:	
Miriam Fields-Babineau	:	DECISION ON PETITION
Application No. 09/736,408	:	REGARDING REQUEST TO
Filed: December 15, 2000	:	WITHDRAW FINALITY
For: COMFORT TRAINER	:	UNDER 37 CFR 1.181
("CANINE HEAD HALTER")	:	

This is in response to appellant's petition under 37 CFR 1.181 filed April 13, 2004 requesting withdrawal of the finality of the Office action mailed November 20, 2003 as being premature.

The petition is **GRANTED**.

Appellant alleges that the final rejection mailed November 20, 2003 is premature because the new ground of rejection contained in the Office action was not necessitated by amendment. It was responsive to appellant's arguments in the appeal brief filed August 7, 2003.

A review of the record reveals that an amendment responsive to a non-final Office action was filed August 20, 2002. A final Office action containing rejections under 35 USC 112, first and second paragraphs, 35 USC 102 and 35 USC 103 was mailed October 7, 2002. Appellant filed a Notice of Appeal on March 10, 2003 and an amendment after final rejection on March 17, 2003. An advisory action mailed April 3, 2003 indicates that the amendment filed March 17, 2003 overcame the rejections under 35 USC 112 and thus would be entered for purposes of Appeal. An appeal brief was filed August 7, 2003. In response to the appeal brief, a new final Office action containing new grounds of rejection was mailed November 20, 2003.

A further review of the record reveals an interview was held December 9, 2003. An amendment after final rejection was filed February 9, 2004 wherein appellant requested the withdrawal of the finality of the Office action mailed November 20, 2003. The advisory action mailed February 27, 2004 indicates the amendment would not be entered because it raises new issues that would require further consideration and/or search and that the finality of the Office action mailed November 20, 2003 was necessitated by appellant's previous amendment filed August 20, 2002 in which claims 7-25 were added.

MPEP 1208.02 sets forth that in reopening prosecution after appeal, an Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was not filed. See MPEP § 706.07 (a).

In view of the fact that there was no intervening amendment between the appeal brief and the final Office action mailed November 20, 2003 and that the newly applied secondary reference, DeGroot, applied against claims 6, 11-14 and 16-21 was not a part of the existing art of record, it is agreed that the new ground of rejection was not necessitated by amendment and the finality of the Office action mailed November 20, 2003 is improper and premature.

Appellant also asserts that the status of exhibits presented in the appeal brief filed August 7, 2003 and represented in the request for reconsideration filed April 13, 2004 is unclear. Although the Examiner did not make the status of the exhibits clear in the Office action mailed November 20, 2003, the Advisory action mailed April 27, 2004 clearly sets forth in item 6 that the exhibits will NOT be considered.

Appellant further alleges that the amendment after final rejection dated February 9, 2004 was filed in response to a request by Examiner Poon given during the examiner's interview. However, a further review of the Examiner's interview summary indicates that no agreement was reached with respect to the claims. Accordingly, the proposed amendment which raises new issues that would require further consideration and/or search was properly indicated as being not entered. Furthermore, there is no requirement that the supervisory examiner, Mr. Jordan, be present during an interview, only that an examiner having negotiating authority be present.

Finally, with respect to appellant's allegation that the Office action of November 20, 2003 is not "complete" because it is unclear if the previous rejections are withdrawn with respect to the claims involved, in the Office action of November 20, 2003 the examiner clearly states "[t]he finality of the rejection of the last Office action ... has been withdrawn. *As such, the following action applies*" (emphasis added). Although the examiner did not state that the previous rejections are withdrawn, it is clear from the last statement that the previous rejections are withdrawn and the rejections contained in the Office action applies.

The finality of the Office action mailed November 20, 2003, but not the action itself, is hereby vacated. The Office action of November 20, 2003 is now considered to be non-final and the shortened statutory period for response continues to run THREE (3) MONTHS from the date of mailing of the Office action, i.e., three (3) months from November 20, 2003. Furthermore, the amendments after final rejection filed February 9, 2004 and August 13, 2004 will be entered.

The application will be forwarded to the Head Supervisory Legal Instruments Examiner for removal of the "final" status from the November 20, 2003 action and for entry of the February 9, 2004 and August 13, 2004 amendments and then to the examiner for consideration of the amendments. However, if either of the amendments raises a new ground of rejection, the next Office action will be made FINAL.

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DH/tl: 9/24/2004

